

Appn. No. 09/752,666
Amendment dated November 1, 2007
Reply to Office Action mailed August 22, 2007

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 1, 2, 7 through 12, 14, 15, 17, 18, 21 through 28 and 30 through 32 remain in this application. Claims 3 through 6, 13, 16, 19, 20, and 33 through 35 have been cancelled. No claims have been withdrawn or added.

Paragraph 6 of the Office Action

Claims 1, 2, 7, 8, 12, 14, 15, 17, 18, 21 through 26 and 29 through 32 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Adams.

Claim 9 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Adams in view of Lambert.

Claim 10 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Adams in view of Blendermann.

Claim 11 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Adams in view of Porter.

Claims 27 and 28 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Adams in view of Reinhardt.

Claim 1 requires "obtaining, by said client system from the user of the client system, an indication of a minimum length of time during which the received data is to be temporarily stored", "storing temporarily on the client system at least a portion of the received data for a period of at least the

Appn. No. 09/752,666
Amendment dated November 1, 2007
Reply to Office Action mailed August 22, 2007

minimum length of time indicated by the user at the client system", and "wherein the obtaining step is performed after the receiving step and before the storing step" (which is disclosed, for example, at page 8, lines 1 through 12 of the specification and in Figure 3) (emphasis added). Claim 12 requires "at said client, entering a time specified by the user for the Web page data associated with the specific Web page", "storing said Web page data for the specific Web page temporarily in a cache", and "wherein the obtaining step is performed after the retrieving step and before the storing step." Claim 14 requires "the client being configured to temporarily store data downloaded from a network for a minimum period of time specified by a user, after which period of time the stored data is subject to automatic deletion, said user specified minimum period of time being specified by an entry made at said input device by the user after the data is downloaded and before the data is stored". Similarly, but not identically, claim 32 requires "obtaining, by said client system from the user of the client system and after receiving the data of the individual Web page and before storing the received data, an indication of a minimum length of time during which the received data for the individual Web page is to be temporarily stored on the client system".

In the rejection of claims 1 and 32, it is stated that:

Adams fails to specifically disclose the specific ordering of the steps where the obtaining step is performed after receiving the data of the individual Web page and before storing the received data. Rather, Adams discloses that the obtaining step is performed "[a]t the time of" (Col 3, Lines 12-16) the receiving step.

While it is agreed that the Adams patent does not disclose the claimed order of events required by the language of the claims, it is again noted that the Adams patent *does not* disclose "at the time of the receiving step", which is sought to be established in the rejection of the Office Action. This is nowhere made more clear than by the portion of Adams referenced in the

Appln. No. 09/752,666
Amendment dated November 1, 2007
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rejection at col. 3., lines 12 through 16, which state in complete form that (all emphasis added):

Keep module 30 in one embodiment is integrated with browser interface 10 in a known manner to provide an option for user 20 when a document is requested through browser interface 10. At the time of the request, user 20 can designate the document as a keep document. In another embodiment, keep module 30 is a separate interface available to user 20. Keep module 30 also allows user 20 to designate any documents already stored in disk 18 by cache control 26 as keep documents.

So, while the rejection states that the Adams patent "discloses that the obtaining step is performed '[a]t the time of' [] the receiving step'", it is clear that the actual disclosure of Adams references the time of the request of the document, and not the time of the receipt of the document.

Also, significantly, the language of claim 1 requires "obtaining, by said client system from the user of the client system, *an indication of a minimum length of time during which the received data is to be temporarily stored*" and "the obtaining step is performed after the receiving step". Thus, the claimed obtaining step does not merely require that the indication obtained simply be an indication that the received data is to be stored, but requires "an indication of *[the] minimum length of time* that the received data is to be stored". The rejection appears to simplify this requirement to merely an indication of whether the received data is to be a "keep document", but there is no indication in Adams that the user is required "at the time of the request" to designate any time frame that a keep document is to be stored, merely that the document be designated as a keep document. While Adams later does make reference to "allow[ing] the user 20 to limit the time frame that a document is designated as a keep document" (see col. 3, lines 23 through 25). One can only speculate as to when this designation *might* happen, but it is noted that the Adams discussion of the time frame states that the user is *allowed* (not required) to limit the time frame, and Adams states that this is "[I]m a further embodiment", neither of which

Appln. No. 09/752,666
Amendment dated November 1, 2007
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suggests that this designation necessarily happens, especially "after [a] receiving step and before [a] storing step" as required by the claim. Thus, one of ordinary skill in the art is left to guess if and when the user of the Adams system limits the time frame as a keep document.

It appears from reviewing the "Response to Arguments" portion of the Office Action (which are further discussed below) that the rejection is based upon the assertion that the order of these events (receiving the data, obtaining a minimum length of time, and storing the received data) does not produce "unexpected results". However, as noted above, there is no clear evidence in Adams that the Adams system requires as a part of the designating the document as a keep document (at the time of the request) the designating a "time frame" as a keep document, as the designation of a time frame appears to some type of option in some embodiments.

Since it is not clear from the Adams patent that the "time frame" designation is actually made and made at the same time that the keep document designation is made, it is submitted that the claimed invention is not suggested by the Adams disclosure as claim requires that the time period is obtained from the user and is obtained after the receiving and before the storing of the data.

Further, where the indication of the time period is made after the receiving step but before (any) storing of the data, the user has the opportunity to review and evaluate the data in order to consider the data when determining and then indicating the time period to store the data. In other words, the user has the opportunity to see and evaluate the data before having to indicate a time period that the data is to be stored, and is able to make that determination at the same time that the decision to store the document is being made. Adams, on the other hand (assuming only for the purposes of argument that the designation of the time frame is part of the designation as a keep document at the time of requesting), requires a user to

Appln. No. 09/752,666
Amendment dated November 1, 2007
Reply to Office Action mailed August 22, 2007

blindly decide before having an opportunity to see the document that the document is worthy of storing and the time frame that the document is worthy of storing. Since the decision to store is made at the time of the request, the user does not have the benefit of reviewing the document, and then may have to go back and delete a document that is not needed.

Further, if the user of the Adams system waits until after the document has been stored to designate the document as a keep document, then the designation might be forgotten. While the Patent Office can speculate about how quickly the retrieving and storing actions of Adams *might* occur, it is also possible and likely that in some circumstances that the retrieval would not occur that quickly, and the user would become distracted, forget or simply lose interest in designating the document as a keep document, if required to wait until after the document is stored.

Turning to the "Response to Arguments" section of the Office Action, it is contended there that:

Each of the three relevant steps, (a) receiving the document, (b) designating the document as a keep document (obtaining step), and (c) storing the document, are performed by Adams. Since the storing step must occur after the receiving step, there are three possible orders (a), (b), (c); (b), (a), (c); and (a), (c), (b). Adams explicitly discloses two of those, as discussed above and in the rejection presented below. The third, (a), (b), (c), is not explicitly disclosed, and corresponds to the claim language of all pending claims.

While the Examiner agrees that Adams fails to explicitly teach designating a document as a "keep document" after it has been received but prior to being stored for a time indicated by a user, performing the steps in that order would not produce **unexpected** results. In this case, the fact that the results may be "more usable" does not mean they are unexpected, and Applicant has provided no evidence or even argument purporting to show that the claimed order produces unexpected results.

The advantages of performing the steps in the claimed order, listed by Applicant, are not "results", nor are they unexpected. It is respectfully submitted that one of ordinary skill in the art, when required to make a determination regarding when to obtain, from a user, an indication of a minimum length of time to store a document, would have seen a benefit to obtaining it after receiving the document

Appln. No. 09/752,666
Amendment dated November 1, 2007
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but before storing it. This would have allowed the user to review the document prior to deciding whether to keep it, and such a benefit would have been entirely expected.

Since it is not entirely clear that the designation of a document at the time of request includes a designation of a "time frame", and since the Adams patent explicitly states that the designation as a keep document occurs at the time of the request, the speculation as to how one of ordinary skill in the art might have altered the explicit timing set forth by Adams without any apparent motivation to do so is submitted to simply attempt to make the Adams disclosure more vague where it's discussion is specific, and more specific where it's discussion is vague.

Further, the "Response to Arguments portion of the final Office Action alleges that:

Additionally, Adams teaches that a document may be designated as a "keep document" "[a]t the time of the request" (Col. 3, Lines 12-16). This language does not explicitly specify an ordering and is sufficiently general to suggest to one of ordinary skill in the art that the designation could occur after the document has received in the browser, but before being stored in the cache. Since the time difference between requesting and receiving a document via the network is typically less than several seconds, the designation would still occur substantially "[a]t the time of the request", but occur immediately following it. One of ordinary skill in the art, upon learning of Adams' disclosure, would have recognized that designating a document as a keep document immediately following the receipt of the document would have been a predictable variation of the explicitly disclosed embodiments.

The supposition that the Adams patent "could" operate in a different manner does not establish that one of ordinary skill in the art would have found it obvious to modify the operation of Adams. Clearly the claimed invention has benefits over the Adams mode of operation, which are submitted to make the claimed invention unobvious over Adams.

Appln. No. 09/752,666
Amendment dated November 1, 2007
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Withdrawal of the §103(a) rejections of claims 1, 2, 7 through 12, 14, 15, 17, 18, 21 through 28 and 30 through 32 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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